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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/28/2005

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EXAMINER

FERNANDES, CHERYL M

ART UNIT PAPER NUMBER

2163

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,921

Applicant(s)

HALL ET AL.

Examiner

Cheryl M. Fernandes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Amendment filed April 8, 2005. Claims 1-9 and 18-26 are pending. Claim 23 is amended. Claims 25 and 26 are added.
2. Applicant's arguments, see pages 8-9, filed April 8, 2005, with respect to the rejection(s) of claim(s) 1, 18, and 23 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent Number 6,304,898 issued to Shiigi.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 18, 19, 20, 22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 6,304,898, issued to Shiigi.

Referring to claim 1, Shiigi discloses a method for sending data using a communications device (Abstract; 'handwriting messaging client', Fig. 1B, element 211; col. 3, lines 33-55), comprising:

- creating a data file for sending using said communications device (user creates a message using a handwriting messaging client, Fig. 4A, elements 6 and 7, col. 8, lines 50-56; col. 3, lines 33-55);
- retrieving at least one destination address from a user's personal database stored remotely from said communications device (User Directory database remote from client, Fig. 2, element 222, contains e-mail addresses of authorized users, col. 4, lines 25-42 and 63-65) for sending said data file to said at least one address (col. 8, lines 31-61; Fig. 4A, elements 4-7); and
- sending said data file to said at least one destination address (col. 8, line 31- col. 9, line 4; Fig. 4A, elements 9-14).

Referring to claim 18, Shiigi discloses a system for sending data from a communications device to a location defined by data in a user's personal database (Abstract; 'handwriting messaging client', Fig. 1B, element 211; col. 3, lines 33-55), comprising:

- a communications device (Abstract; 'handwriting messaging client', Fig. 1B, element 211; col. 3, lines 33-55) for sending data to at least one specified address (see Summary of Invention); and

- means for accessing a personal database stored remotely from said communications device (User Directory database remote from client, Fig. 2, element 222, contains e-mail addresses of authorized users, col. 4, lines 25-42 and 63-65; user accesses a list of authorized registered active users found in the server holding the User directory database, col. 8, lines 31-54) to retrieve the at least one specified address (col. 8, lines 31-54; Fig. 4A, elements 4 and 5).

Referring to claim 2, Shiigi discloses identifying a user of said communications device ('user authentication', col. 4, lines 32-34) and accessing a personal database of said user (user accesses a list or User directory of authorized registered active users, the directory containing the authorized users' email addresses, col. 8, lines 31-54; col. 4, lines 32-34 and 63-65).

Referring to claim 3, Shiigi discloses logging onto a server for hosting a storage media for storing said personal database of said user, retrieving data from said personal database of said user, and displaying said retrieved data to said user through said communications device (col. 4, lines 25-42 and 63-65; Fig. 4A, element 2).

Referring to claim 4, Shiigi discloses connecting to said server using the Internet (col. 3, lines 35-39).

Referring to claim 5, Shiigi discloses retrieving a server location associated with a user from a directory service, accessing said server location, accessing said user's personal database through said server location (col. 4, lines 26-34; col. 4, lines 63-65; col. 8, lines 39-49), and selecting at least one destination address from said user's personal database with said communications device (col. 8, lines 31-52, Fig. 4A, element 5).

Referring to claims 6 and 7, Shiigi discloses prompting said user to enter a secure identification string into said communications device, connecting to said directory service, and determining said server location and username from data associated with said secure identification string accessible to said director service (col. 8, lines 39-61, Fig. 4A, elements 2-10).

Referring to claim 8, Shiigi discloses selecting at least one destination address from the group consisting of e-mail addresses, facsimile numbers, phone numbers, and uniform resource locators (User Directory contains authorized users' email addresses, col. 4, lines 63-65; Fig. 4A, elements 3-5).

Referring to claim 19, Shiigi discloses a server that stores a personal database ('server computer' contains User Directory database, col. 4, lines 26-42 and 63-65; Fig. 1B, elements 220 and 222).

Referring to claim 20, Shiigi discloses storing said personal database on a server in communication with said communications device (server computer containing User Directory database is in communication with client computer, Fig. 1A; Fig. 1B, element 222; col. 3, lines 33-58; col. 4, lines 63-65).

Referring to claim 22, Shiigi discloses means for connecting to an Internet connection for facilitating communications between a communications device and said server (see Fig.1A).

Referring to claim 24, Shiigi discloses:

- identifying a user of said communications device ('user authentication', col. 4, lines 32-34; 'PDA' client device, col. 3, lines 49-55, Fig. 4A, elements 2-3, col. 8, lines 39-45);
- connecting to a directory server for retrieving a username of said user and a server identification (col. 4, lines 26-34 and 63-65; Fig. 4A, elements 3-5, col. 8, lines 31-49);
- constructing a messaging application program interface profile for connecting to a server associated with said server identification ('Handwriting Messaging server', Fig. 1B; 'user name' for logging into server, Fig. 4A, element 2, col. 8, lines 39-40);
- connecting to said server, logging in to said server as said user using said username (col. 8, lines 30-49, Fig. 4A, elements 1-5, col. 8, lines 39-49); and

- accessing the personal database of said user to retrieve the at least one destination address (refer to claim 2 addressed above).

4. Claims 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 6,577,907, issued to Czyszczewski et al (hereafter Czyszczewski).

Referring to claim 25, Czyszczewski discloses a multifunctional device (Abstract; Fig. 1) comprising:

- a facsimile for transmitting facsimile communications to one or more destinations and for receiving facsimile communications (Abstract; Field of Invention; col. 1, lines 47-52; col. 3, lines 8-10; col. 5, lines 6-20; col. 7, lines 12-25; col. 10, lines 21-27); and
- means for accessing a personal database ('multi-function controller', Fig. 5, element 25) maintained on a remote device from the multifunctional device (remote 'Corporate Directory database', Fig. 5, element 185) and for retrieving address information from the personal database to be used as the one or more destinations by the facsimile when transmitting facsimile communications ('user profiles comprising user contact data and fax number' are retrieved from the Corporate Directory database, col. 9, lines 20-49, see Fig. 5; Fig. 9B-C, col. 12, lines 34-59).

Referring to claim 26, Czyszczewski discloses further including a printer operably connected to the facsimile and the means for accessing (see Fig. 5, where a printer 43 is connected to the facsimile comprising the multi-function controller 25; col. 1, lines 47-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiigi, as applied to claims 5 and 18 above, and further in view of Patent Number 6,609,121 issued to Ambrosini et al (hereafter Ambrosini).

Referring to claims 9 and 21, Shiigi discloses all of the above claimed subject matter but remains silent as to a lightweight directory access protocol interface for storing information.

However, Ambrosini teaches analogous art that includes a lightweight directory access protocol interface for storing information (Abstract; Fig. 1-2).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Shiigi to include a lightweight directory access protocol interface for storing information, as taught by Ambrosini.

The ordinary skilled artisan would have been motivated to modify Shiigi per the above for the purpose of providing a consistent and controlled system for accessing data (Ambrosini, col. 2, lines 16-20).

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiigi, as applied to claim 18 above, and further in view of US Patent Number 6,577,907, issued to Czyszczewski et al (hereafter Czyszczewski).

Referring to claim 23, Shiigi discloses all of the above claimed subject matter but remains silent as to the communications device being a multifunctional device comprising a facsimile.

However, Czyszczewski teaches analogous art that includes a multifunctional device comprising a facsimile (Fig. 1, element 135; Fig. 9B-C; col. 1, lines 47-54; col. 12, lines 34-59).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Shiigi to include a multifunctional device comprising a facsimile, as taught by Czyszczewski.

The ordinary skilled artisan would have been motivated to modify Shiigi per the above for the purpose of integrating facsimile functions within a multifunction device to

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allow for sending and receiving of facsimile messages (Czyszczewski, Field of Invention; col. 1, lines 49-52).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M Fernandes who can be reached on (571) 272-4018. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 16, 2005
CMF



UYEN LE
PRIMARY EXAMINER